Supreme Court, U.S.
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No. 01-1087

IN THE

Supreme Court of the United States

KUSTOM SIGNALS, INC.,

Petitioner,

v.

APPLIED CONCEPTS, INC. AND JOHN L. AKER,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION TO WRIT OF CERTIORARI

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QUESTION PRESENTED

Petitioner's patent describes and claims an invention that requires "operator control for selecting either a greatest magnitude or highest frequency search, whereby either strongest signal or fastest signal target identification is provided." In the face of rejections by the patent office based on prior art, the inventor amended the claims and argued that the claimed invention required "searching capabilities . . . to provide multi-mode operation," and "specifically requires two search modes under operator selection." In its reply brief filed in the Federal Circuit, Petitioner admitted that the accused devices "do not have any operator selectable search modes." Despite these undisputed facts, Petitioner argues that the Federal Circuit erroneously limited the claimed invention to a device that includes operator selectable search modes. The question presented by the petition, therefore, is:

Whether the Federal Circuit properly concluded, based on the patent claims, the specification, and the prosecution history, that the claims could not be stretched to cover a device that admittedly lacks operator selectable search modes?

CORPORATE DISCLOSURE STATEMENT

There are no parent corporations of Respondents and there are no publicly held companies that own 10% or more of the stock in Respondents.

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BRIEF IN OPPOSITION

The Federal Circuit concluded that the invention as described in the '246 patent, and as amended and argued during prosecution before the patent office, requires operator-selectable search modes, and that Petitioner could not stretch the claims to cover a device that admittedly lacks operator-selectable search modes. Petitioner contends that the Federal Circuit, which made no mention of its earlier decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000)(*en banc*), *cert. granted*, 121 S. Ct. 2519 (2001), nevertheless applied a "complete bar" rule under the principles of *Festo* and thereby improperly limited the scope of the patented invention. Petitioner's arguments mischaracterize the Federal Circuit's actions and do not warrant granting *certiorari.*

STATEMENT OF THE CASE

A. The '246 Patent Prosecution History

Petitioner's patent application, including original claims 1-20, was filed on June 30, 1994. The abstract of the patent explains that:

> It is also an important object of the invention to provide the methods and apparatus as aforesaid in a traffic radar unit *in which various modes of operation may be selected by the operator, including stationary modes in which either the strongest or fastest signal may be selected* . . . .

Petitioner's Lodging at L-1. The patent repeatedly emphasizes these operator-selectable modes. For example, the patent states that:

> It is also *an important object* of the invention to provide . . . stationary *modes in which either the strongest or the fastest signal may be selected*, moving modes in which oncoming traffic in the opposite lane may be detected *on either a strongest or fastest signal basis*, and moving modes . . . .
>
> A further *and important object* of the present invention is to provide a traffic radar . . . [including] Doppler components which may be examined *in accordance with the operational mode selected* . . . .

Petitioner's Lodging at L-35, column 2 at lines 4-20.

The patent identifies six distinct modes of operation, each of which can be "selected by the user." Lodging at L-37, column 5 at lines 21-35. When the first mode is selected by the user, the device "searches for the strongest signal." Lodging at L-37, column 6 at lines 25-27. When the second mode is selected by the user, the device "searches for the fastest signal." Lodging at L-37, column 6 at lines 42-44. All of these various modes are described in mutually exclusive terms; there is no indication that different types of searches can be performed independently of the mode in which the device has been placed. Nowhere does the patent suggest that both a fastest and a strongest search can be performed.

The flow charts explaining the processing steps in the patent include branches leading to different searches depending on the mode selected by the user. Figure 25 at steps 104 and 105 shows a processing fork based on whether the device has been placed in a "fastest mode;" if such a mode has been selected, processing proceeds to "fastest target" processing. Lodging at L-26. Similarly, Figure 30 shows a processing fork at step 154 based on whether the device has been placed in a "fastest mode." If the device has been placed in a "fastest mode," the figure shows a step of "GO TO 156 FASTEST STATIONARY TARGET SEARCH." If that mode has not been selected, the figure shows a step of "GO TO 164 STRONGEST STATIONARY TARGET SEARCH." Lodging at L-31. Every instance of searching described in the patent is based on the operator-selected mode.

Finally, the structure shown in the '246 patent is capable of displaying only a single target speed, which is dependent on the type of search selected by the operator. Only a single display window is provided for displaying one operator-selected target speed. Lodging at L-2 (element 204 in Figure 1). There is no possible way of displaying two different target speeds on the device; only one operator-selected type of target speed can be displayed at a time.

The patent office rejected all 20 original claims under 35 U.S.C. § 103 (obviousness) as being unpatentable over a prior art radar detector, the Muni Quip MDR-1, in combination with another United States Patent. Lodging at L-56 to L-58.

In response to the claim rejections, the applicants took two independent actions to persuade the patent office to

allow the patent. First, applicants canceled claims 1-20 and substituted new claims 21-42. Lodging at L-43 to L-52. Applicants explained to the patent office that independent claims 1, 16, and 20 had been canceled "in favor of new [independent] claims 22, 37, and 41 respectively." Lodging at L-53. Applicants noted that "the claims now call for storing the frequency components in memory *and searching the stored components in the manner as set forth in claims 22, 37 and 41 respectively*." Lodging at L-53 (emphasis added). Thus, applicants drew attention to the specific searching features newly recited in the claims.

The new claims replaced language in original claims 1 and 16 relating to determining a magnitude *and* frequency of each valid component with language directed to *searching* the components for "*the component* that meets preselected magnitude *or* frequency criteria." Lodging at L-44 and L-50.

Second, the applicants argued that the claims were distinguishable from the prior art because of the unique "search modes" required by the new claims. As to independent claim 41, which became claim 20 in the issued patent, the applicants argued that, "Claim 41 specifically calls for two search modes under operator selection." Lodging at L-54. As to all of the new claims, the applicants also argued that the prior art was distinguishable because "transformation to the frequency domain *and the searching capabilities of the present invention to provide multi-mode operation, as claimed, are not disclosed.* Accordingly, independent claims 22, 37, and 41 [corresponding to issued claims 1, 16, and 20] are clearly nonobvious and allowable." Lodging at L-54 (emphasis added). Following these amendments and arguments, the patent office issued the patent.

Petitioner argues on page 5 of its brief that:

> The purpose of these changes was not to narrow the scope of the claims to avoid the prior art, but to more distinctly claim the patentable subject matter of the invention. The new claims no longer recited limitations directed to a validation process but rather to the search for stored data.

Petitioner's suggestion that the amendments and arguments were not made to avoid the prior art is contrary to the record. The amendments were clearly made in response to obviousness rejections by the patent office (Lodging at L-56 to L-58); they clearly narrowed the claims because they added several additional steps not found in the original claims (Petitioner's brief at App. 30a to 34a); and the applicant specifically argued that the "searching capabilities of the present invention to provide multi-mode operation, as claimed, are not disclosed [in the prior art]." Lodging at L-54.

Moreover, contrary to Petitioner's statement that the validation process was no longer included in the claims, the district court interpreted the claimed "search" function in these new claims to specifically include the spectrum validation process that allegedly was deleted from the original claims. Petitioner's brief at App. 52a-54a. Not only did Petitioner urge such an interpretation below (see App. 52a), Petitioner repeated this interpretation of the claims on page 24 of its opening brief to the Federal Circuit. This interpretation was beneficial to Petitioner in the district court because had the claims not been so interpreted, they likely

would have been found invalid. Petitioner's brief at App. 48a to 54a.

Petitioner also argued on pages 2-3 of its Petition for Rehearing in the Federal Circuit that the claimed search function required "initial signal validation steps to suppress noise and false or misleading signals, followed by saving the validated signals in an array in the memory." For Petitioner to now suggest that the newly filed claims no longer included the validation process is untenable.

On page 6 of its brief, Petitioner argues that the new claims "are directed toward *selectability of data presentation*," which Petitioner says "gives the operator the option to select either fastest or strongest *data*." Petitioner seems to focus on the overall effect of the data that is presented to the operator of the device.

The problem with this characterization of the amended claims is that it ignores entirely the language of the claims. The amended (and issued) claims specifically require "*searching* said components in memory for *the component* that meets preselected magnitude *or frequency criteria*, and indicating the speed of the target vehicle *corresponding to the component* that meets said criteria." Lodging at L-44 (claim 22); L-50 (claim 37); L-52 (claim 41). These claims say nothing about "selectability of data presentation" as urged by Petitioner; the claims require *searching for a component* and then indicating the results of that search.

B. The District Court Proceedings

After being sued by Petitioner in the district court for patent infringement, Respondents filed a motion for summary judgment of noninfringement. The district court granted in part Respondents' motion, concluding after careful analysis that the accused Stalker Dual radar detectors could not literally infringe independent claims 1, 16, and 20 because they required "the search and display of a single fastest or strongest target, depending on the mode selected by the operator. In contrast, the Stalker Dual radars always perform a search for both a fastest and a strongest target." Petitioner's brief at App. 109a. This conclusion was based on the district court's interpretation of the disputed claim terms "or," "criteria," and "preselected." The district court concluded based on the language of the claims, the specification, and the prosecution history that the claims required an alternative search for either a strongest type search or a fastest type search, but not both types of searches. Interpreting the claims to include both types of searches would have effectively ignored the "operator mode selection" feature of the patented invention. Petitioner's brief at App. 102a.

Because of the limited briefing and its perception that disputed fact issues remained, the district court declined to grant summary judgment to Respondents on the question of infringement under the doctrine of equivalents. Petitioner's brief at App. 114a. The district court suggested that prosecution history estoppel would not apply, based on the district court's narrow reading of the arguments and amendments made by the applicants. Petitioner's brief at App. 115a-116a.

Respondents filed a renewed motion for summary judgment on the issue of infringement under the doctrine of equivalents. The district court, acting through Judge Vratil (who replaced deceased Judge O'Connor), granted the motion, concluding that no infringement was possible under that doctrine.

The district court granted Respondents' motion on two independent grounds. First, the court found that under the "all elements rule," infringement was not possible because one of the claimed elements was undisputedly missing from the accused device. According to the district court, the missing element was the feature requiring that the claimed radar must search or display either the strongest or fastest target but not both. Petitioner's brief at App. 63a to 64a.

As a second and independent basis for its decision, the district court concluded that no reasonable jury could find infringement under the doctrine of equivalents because the patented and accused radars performed substantially different search functions and produced substantially different results. Petitioner's brief at App. 68a-73a. In making this determination, the district court relied on this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). Petitioner's brief at App. 69a.

C. The Federal Circuit's Decision

The Federal Circuit agreed with the district court that the claim construction issues in this case turned on the meaning of the terms "or" and "either" as used in the claims. Petitioner's brief at App. 9a. In its opinion, the Federal

Circuit noted that the '246 patent described a device in which only a single type of search is performed depending on the mode selected by the operator. Petitioner's brief at App. 9a-10a. The Federal Circuit recognized that the amendments to the claims and arguments highlighting the "multi-mode" operation achieved by operator selection of either a fastest or strongest mode dictated the distinct search modes of the claims. Petitioner's brief at App. 9a-10a. The Federal Circuit pointed to the applicants' argument, in the face of a prior art rejection by the patent office, that claim 20 (original claim 41) "specifically calls for two search modes under operator selection." Petitioner's brief at App. 10a. Based on this intrinsic evidence, the Federal Circuit agreed with the district court that operator selection of alternative searches was required by all of the claims. *Id.*

The Federal Circuit then compared the properly interpreted claims to the accused Stalker Dual radars. As to literal infringement, the Federal Circuit agreed that the claims could not literally cover a device that did not permit the operator to select the type of search that was to be performed. Petitioner's brief at App. 11a. Regarding infringement under the doctrine of equivalents, the Federal Circuit disagreed with the district court's application of the "all elements rule," concluding that the rule was not implicated in this case because the word "or" was not itself an "element" of the claims. Petitioner's brief at App. 13a. However, the Federal Circuit agreed with the district court's alternative ground for its ruling, which was based on this Court's decision in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950). Both the district court and the Federal Circuit agreed that the accused device's methodology of automatically searching both magnitude and frequency data was a substantially different

way of operation, compared with the patented invention's operator-initiated search of either magnitude or frequency data. In short, no reasonable jury could find equivalency in fact. Petitioner's brief at App. 13a.

Although the Federal Circuit stated that the district court found that Petitioner was estopped from relying on the position that a device which searches for both fastest and strongest targets performs substantially the same function as a device which searches for either the fastest or strongest target, that statement merely drew attention to the fact that Petitioner had argued to the patent office that the differences between "multi-mode" searching functions and devices that lacked such features were substantial. While the Federal Circuit's decision can arguably be read to blend notions of estoppel with equivalency in fact, the decision is best understood as upholding the district court's ruling on the basis of lack of equivalency in fact based on differences highlighted by the patent applicants during prosecution. Petitioner's brief at App. 13a-14a.

Nevertheless, Respondents had vigorously argued to the Federal Circuit that Petitioner was precluded by the prosecution history from asserting a claim scope that covered devices that lacked an operator-controlled search mode, which applicants had argued distinguished the claimed invention from the prior art. Even reading the Federal Circuit's opinion as relying in part on prosecution history estoppel, the opinion made no reference to *Festo* and did not invoke any sort of "complete bar" as now alleged by Petitioner. Instead, Petitioner was merely precluded from reasserting the specific subject matter – lack of operator-selectable search modes – that the patent applicant had insisted to the patent office was required by the claims.

Chief Judge Mayer dissented based on a strained reading of the specification. Agreeing with Petitioner below, and relying on a specialized "Boolean" definition of the word "or" for which Petitioner had invited the Federal Circuit to take judicial notice, Chief Judge Mayer interpreted the claims to be broader. This interpretation is inconsistent with Figure 25, which demonstrates that the alternatives to be selected are mutually exclusive. Lodging at L-26. The dissenting opinion made no mention of the applicant's arguments during prosecution highlighting the "multi-mode operation" of the claimed invention and arguing that the claims required "two search modes under operator control." Neither the majority nor dissenting opinions mentioned the *Festo* decision pressed so urgently by Petitioner in this Court.

REASONS FOR DENYING THE PETITION

Petitioner has raised a multitude of issues in its Petition, at least one of which (Question 4, Petition at *ii*) has been raised for the first time in this Court.[1] Despite Petitioner's attempts to fit this case into the mold of *Festo*, the Federal Circuit's decision is not dependent on that case. Moreover, Petitioner has mischaracterized a number of aspects of the proceedings below, and has ignored established precedent of both the Federal Circuit and this Court in urging reversal. Finally, Petitioner's suggested interpretation of the claims would cover an accused device that only performed a single type of search, which is notoriously old in the prior art. Because none of Petitioner's

[1] This Court should decline to entertain this new issue.

arguments warrants disturbing the judgment, the petition should be denied.

A. The Federal Circuit's Decision is Not Dependent on *Festo*

Much of Petitioner's brief is devoted to attacking the Federal Circuit's *en banc* decision in another case, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000)(*en banc*). According to Petitioner, the Federal Circuit in this case improperly applied the "complete bar" rule of *Festo*, thus precluding Petitioner from asserting equivalence under the doctrine of equivalents.

The Federal Circuit did not rely on the "complete bar" rule of *Festo*. As pointed out above, neither the majority nor dissenting opinion mentioned *Festo* or any of its progeny, and neither the majority nor dissenting opinion referred to any sort of "complete bar" as contended by Petitioner. Nor did the majority or dissenting opinion refer to any presumption that the amendments were made for reasons of patentability. In concluding that no infringement was possible, the Federal Circuit cited this Court's decision in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950). Petitioner's brief at App. 13a.

The Federal Circuit's decision is consistent with long-standing precedent of this Court. It has long been held that claims must be interpreted in light of the prosecution history, including amendments and arguments made by the patentee to avoid prior art. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 133-134 (1942). This analysis includes reading and interpreting claims with reference to claims that were canceled or surrendered during prosecution. *Schriber-*

Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 218 (1940)("Where the patentee in the course of his application has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed."); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966).

A term in a claim may not be given an interpretation that is contrary to a limitation that the patentee placed upon his invention during prosecution. *Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42, 46 (1935). As this Court explained in *Keystone Driller*, statements made by the patentee during prosecution may result in a disclaimer of subject matter, even where the statements do not rise to the level of estoppel: "We do not attribute the force of an estoppel to what was said by the claimant in seeking to avoid the prior art, but we do apply the principle that, where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the equivalent of those which were rejected."

Federal Circuit precedent pre-dating *Festo* also supports the Federal Circuit's decision. Amendments made by the applicant during prosecution can properly be used to interpret the meaning of the claims, even for purposes of evaluating literal infringement. In *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 1283 (Fed. Cir. 1986), a "clarifying" amendment changed the phrase "closely adjacent" to "in contacting relation." The Federal Circuit held that in light of the prosecution history, the amended language precluded a finding of literal infringement for structure that was not physically touching.

In *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867 (Fed. Cir. 1985) (overruled by *Nobelpharma AB v. Implant Innovations Inc.*, 141 F.3d 1059 (Fed. Cir. 1998) on antitrust issues only), the applicant argued a particular meaning of the term "anaerobic" to distinguish prior art. The Federal Circuit held that the applicant's statements during prosecution limited the definition of the term, even though the art recognized a broader definition and the specification did not use the term in such a limiting way.

Long-standing precedent provides that statements made during prosecution can amount to a disclaimer of subject matter from the literal scope of the claim. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985) ("the prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance."). In *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988), the Federal Circuit held that the district court erred by failing to limit the construction of the claims in light of remarks made by the patentee during prosecution. *See also, Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1377 (Fed. Cir. 1999)(attorney argument constituted "clear and unmistakable surrender" of subject matter even though claim was not amended). Consequently, even had the claims not been amended in this case, Petitioner would still be bound by the "operator-selectable search mode" arguments made to the patent office.

There was no "complete bar" applied in this case. The Federal Circuit pointed to applicant's statements during prosecution, which were made in the face of prior art rejections, and concluded that applicants could not recapture

through the doctrine of equivalents the very feature that applicants had disclaimed during prosecution. To summarize the state of affairs succinctly:

(1) Applicants argued during prosecution that, "Claim 41 specifically calls for two search modes under operator selection." Lodging at L-54. The Federal Circuit properly relied on this statement and others, including the applicant's assertion that "the searching capabilities of the present invention to provide multi-mode operation, as claimed, are not disclosed [in the prior art]," Lodging at L-54, to conclude that applicants had urged the patent office to interpret the claims of the patent to specifically require multiple search modes under operator selection. This gave meaning to the "or," "either," and "criteria" language appearing in the claims.

(2) The statements made to the patent office amounted to a disclaimer of subject matter. Devices that lacked "search modes under operator selection" were excluded from the scope of the claims, as urged by the applicants. No further inquiry is needed to determine why applicants made such statements, even though it is evident that the statements were made in conjunction with an amendment and in the face of a prior art rejection.

(3) Petitioner admitted on page 8 of its reply brief in the Federal Circuit that the accused devices "do not have any operator selectable search modes." The district court and the Federal Circuit correctly concluded that this constituted a substantial difference from the properly interpreted claims.

(4) Because the accused devices lack the very feature urged by applicants to be required by the claims, Petitioner is

precluded from asserting that the claims can cover the accused devices. This principle follows both under a literal infringement analysis and under a doctrine of equivalents infringement analysis, due to the substantial differences between the accused device and the properly construed claims.

Chief Judge Mayer's dissent focuses on the patent's drawings and specification, and concludes that a Boolean-type definition of "or" is appropriate. This conclusion is inconsistent with the specification and ignores the patentee's limiting statements made during prosecution. The dissent's failure to consider the patentee's statements short-circuits the principles of claim construction articulated by this Court and the Federal Circuit.

B. The Federal Circuit Properly Relied on the Prosecution History to Interpret the Meaning of the Claims

Petitioner argues at page 9 of its brief, "Despite no finding of prosecution history estoppel by the district court, the Federal Circuit applied prosecution history estoppel to invoke a complete bar to infringement by equivalents. . . . The Federal Circuit sidestepped the issue of literal infringement . . . ." Petitioner has confused the two distinct uses of prosecution history.

As explained by the Federal Circuit in *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 862-863 (Fed. Cir. 1991), the prosecution history is first used in determining the literal scope of a claim. Although the doctrine of prosecution history estoppel technically is irrelevant to the determination of a claim's literal scope, a

particular interpretation may have been disclaimed by the applicant during prosecution, thereby placing such an interpretation outside the *literal* scope of the claim. Once having properly construed the claim – and finding no literal infringement – prosecution history estoppel may bar a finding of infringement under the doctrine of equivalents.'

Contrary to Petitioner's arguments, the majority did not rely on "prosecution history estoppel" in finding no *literal* infringement. The majority properly looked to the prosecution history in construing the claims. The Federal Circuit's opinion includes an entire heading entitled "Literal Infringement" (Petitioner's brief at App. 11a to 12a), under which the Federal Circuit stated that "the accused traffic radar device does not merely practice an additional function or perform an additional step; *it performs a function explicitly moved outside the scope of the claims*, for the alternative "or" excludes devices that search both magnitude and frequency." In other words, the operator-selectable search for either magnitude or frequency was entirely missing from a device that provided no such selection.

After agreeing with the district court's finding that the claims were not literally infringed, the majority then considered the doctrine of equivalents. Although the majority rejected the district court's "all elements" analysis, it affirmed the alternative grounds for non-infringement based on the function/way/result test articulated by this Court in *Graver Tank*.

At pages 18-19 of its brief, Petitioner argues that the Federal Circuit has created a system of "double prosecution history estoppel." Again, Petitioner attempts to muddy the waters between claim construction and prosecution history

estoppel. This is hardly a "new system," as Petitioner urges. The Federal Circuit has explained this dual role of the prosecution history: "Interpreting claims in view of the prosecution history applies as a preliminary step in determining literal infringement. Prosecution history estoppel applies as a limitation to the doctrine of equivalents *after* the claims have been properly interpreted and no literal infringement is found. Estoppel does not involve a reinterpretation of the claims." *Loctite*, 781 F.2d at 870-871. (emphasis in original); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 890 (Fed. Cir. 1984) (determination of prosecution history estoppel does not involve a reinterpretation of the claims as written).

Petitioner also contends that the Federal Circuit may not apply prosecution history estoppel in an amended claim without inquiry into the reasons for the amendment, and contends that the Federal Circuit made no such inquiry.

The Federal Circuit did in fact inquire into the reason for the amendment in this case, and concluded that the amendment was made to avoid the prior art. As to Petitioner's suggestion on page 9 of its petition that the Federal Circuit unfairly found prosecution history estoppel despite a contrary preliminary finding by the district court, it is well established that prosecution history estoppel is a purely legal issue, *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 389 (Fed. Cir. 1984), and the Federal Circuit was free to affirm the judgment on any ground supported by the record. *Glaxo, Inc. v. Torpharm, Inc.*, 153 F.3d 1366, 1371-72 (Fed. Cir. 1998).

Prosecution history estoppel may arise by arguments made during prosecution, even without amendments, where

the arguments are sufficient to evince a clear and unmistakable surrender of subject matter. *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 952 (Fed. Cir. 1993). Estoppel can arise by argument alone, even if the argument is not necessary to distinguish prior art. *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174-75 (Fed. Cir. 1993); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995)(patent owner precluded from showing equivalence of two-step process after distinguishing two-step process during prosecution from its one-step process).

Applicants' statements during prosecution that, "the claims now call for storing the frequency components in memory and searching the stored components in the manner as set forth in claims 22, 37 and 41 [corresponding to issued claims 1, 16, and 20] respectively" and that "Claim 41 specifically calls for two search modes under operator selection" evince an unmistakable surrender of devices that lack search modes under operator selection. Because the accused device admittedly lacks operator selectable search modes, the Federal Circuit properly held that it does not infringe under the doctrine of equivalents in light of this clear and unmistakable surrender.

The Federal Circuit properly looked to the language of independent claim 20 to determine the meaning of the "or" requirement of independent claims 1 and 16. Other claims in a patent may be considered to determine the scope and meaning of claim terminology. *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565 (Fed. Cir. 1983); *see also Phonometrics, Inc. v. Northern Telecom Inc.*, 133 F.3d 1459 (Fed. Cir. 1998)(repeated occurrences of the term

"substantially instantaneously" in the patent should be interpreted consistently).

The applicants' statements clearly indicate that claims 1, 16, and 20 include the same operator-selectable search modes. The applicants referred to "storing the frequency components in memory and searching the stored components in the manner as set forth in claims 22, 37, and 47 [corresponding to issued claims 1, 16, and 20] respectively." Nothing in the prosecution history indicates that the "or" language of claims 1 and 16 should be construed differently than the "or" language of claim 20. The Federal Circuit properly looked to the language of claim 20 and properly concluded that claims 1 and 16 should be interpreted consistently with claim 20.

Finally, the abstract hypothetical posed by Chief Judge Mayer's dissenting opinion – that "If it hails or snows today, we will close the store" allows for the possibility that both could occur – ignores the operator selection requirement urged by the patent applicant during prosecution in this case. The analogy merely illustrates Boolean logic.

A better analogy takes into account the requirement for selection: An automobile approaching a fork in the road must go left *or* right. It is physically impossible for both alternatives to be selected. Figure 25 of the patent illustrates such a fork, for which one and only one alternative must be selected. Lodging at L-26.

C. Petitioner's "All Limitations Are Present" Argument is Misplaced

Petitioner argues at page 7 that the Federal Circuit found no literal infringement despite finding that all "elements" were present. Petitioner urges an overly simplistic and improper test for literal infringement, suggesting in essence that the court should look no further than to whether all claimed "elements" are present, and should ignore other language that excludes subject matter from the scope of the claim. That is not the law.

Infringement is determined by comparing the accused device to the properly and previously construed claims, which necessarily involves interpreting all of the claim language. *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984). The Federal Circuit found that "the accused traffic radar device does not merely practice an additional function or perform an additional step; it performs a function explicitly moved outside the scope of the claims, for the alternative 'or' excludes devices that search both magnitude and frequency." Put another way, the Federal Circuit did not find that all "elements" were present, as Petitioner suggests, but rather found that the claimed search "element" was not present in the accused device because the accused device's function was expressly excluded from the claims.

D. Canceling Claims and Submitting New Claims Does Not Avoid Application of Prosecution History Estoppel

Petitioner argues at page 8 of its brief that the Federal Circuit erred in stating that the claims were "amended," when in fact the original claims were canceled and new claims added. It has long been recognized that when a claim limitation is added to overcome a prior art rejection, the prosecution history effect is the same whether the limitation is added by amendment or by presenting a new claim. *Pall Corp. v. Hemasure Inc.*, 181 F.3d 1305 (Fed. Cir. 1999). In *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255 (Fed. Cir. 1985), the Federal Circuit noted that ignoring differences between newly added claims and originally filed claims in a doctrine of equivalents analysis would "exalt form over substance and distort the logic of this jurisprudence." *Id.* at 260.

This Court has also recognized that prosecution history estoppel can result from not only amending claims, but also from replacing canceled claims with new claims containing additional limitations. *Schriber-Schroth,* 311 U.S. at 221-222.

Whether or not the claims were technically amended, the effect of the prosecution history is that additional limitations were introduced vis-à-vis the newly added claims in the face of a prior art rejection. For purposes of prosecution history estoppel, the effect is the same as if the originally filed claims had been amended to contain the additional limitations.

E. The Federal Circuit's Decision Can Be Independently Sustained Based on Lack of Equivalence as a Matter of Law

The district court concluded that, even if equivalence was not precluded by the all-elements rule, and even if no prosecution history estoppel applied, Petitioner could not succeed because no reasonable jury could find that the accused and patented devices were equivalent. The district court's extensive analysis of the many differences between the claimed invention and the accused device are set forth in Petitioner's brief at App. 68a to 73a.

The Federal Circuit cited with approval the district court's equivalency analysis, Petitioner's brief at App. 13a-14a, in which the district court applied the function/way/result test of *Graver Tank* and concluded that no reasonable jury could find equivalence. The Federal Circuit referred to this as an "alternative ground" on which the decision could be sustained. The last sentence of the Federal Circuit's opinion states that, "We affirm the grant of summary judgment of noninfringement on this alternative ground." Petitioner's brief at App. 14a.

Although the Federal Circuit referred to prosecution history that "estops" Petitioner from relying on certain positions, the Federal Circuit's reference to arguments made by the inventor made during prosecution of the patent can be read as highlighting the importance that the inventor himself placed on operator-selectable search modes, and the lack of such modes in the accused device constituted more than an "insubstantial difference" in the operation of the device. Consequently, the Federal Circuit's judgment can be sustained on this additional ground.

CONCLUSION

The petition raises no important question requiring resolution by this Court. Petitioner has misapprehended important aspects of the decisions rendered by the district court and the Federal Circuit, and is improperly attempting to ride the coattails of *Festo*. The petition should be denied.

Respectfully submitted,

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